

REMARKS

In the June 14, 2005 Office Action, the Examiner noted that claims 1-5, 7, 8 and 10-21 were pending in the application; rejected claims 1-5 and 16 under the first and second paragraphs of 35 U.S.C. § 112; rejected claim 16 under 35 USC § 102(e); and rejected claims 1-5, 7, 8, 10-15 and 17-21 under 35 USC § 103. In rejecting the claims, U.S. Patents 6,675,170 to Flake (Reference A in the March 15, 2004 Office Action); 6,327,590 to Chidlovskii et al.; 6,269,368 to Diamond; (References A and B, respectively in the December 20, 2004 Office Action); and 6,078,913 to Aoki et al. (Reference A in the September 17, 2003 Office Action); and U.S. Patent Application Publication 2002/0065671 to Goerz, Jr. et al. (Reference C in the December 20, 2004 Office Action) were cited. Claim 22 has been added and thus, claims 1-5, 7, 8 and 10-22 remain in the case. The Examiner's rejections are traversed below.

Rejections under 35 USC § 112, First Paragraph

On pages 2-3 of the Office Action, claims 1-5 and 16 were rejected under the first paragraph of 35 USC as failing to comply with the written description requirement. Specifically, the Examiner indicated an inability to understand the term "reference relation" used in the claims, despite the use of terms, such as "semantic relation" (e.g., page 3, line 19), the phrase "relation to a job" (page 5, lines 18 and 19), "relation of a document" (e.g., page 25, lines 4-5), "relations in reference" (page 58, line 6), "relations with a document" (page 58, line 8-9), "relations with a referring document" (page 58, lines 11-12), etc.

Given the Examiner's difficulty in understanding the terminology used in the claims, claim 1 has been extensively amended based on the disclosure at page 20, line 9 to page 23, line 2 of the application to use different words and claim 22 has been added with a scope similar to claim 1 using language that has been changed even more. In place of the term "reference relation" claim 1 now recites "a reference of each document in the collected document, the reference defining a relationship between referring documents and reference document inside or outside the community which are linked to the referring document" (claim 1, lines 5-8) as described at, e.g., page 32 and illustrated in Figs. 3 and 4. As indicated by Fig. 4, the "reference" stored in reference table 121 only indicates the existence of the link from a referring document to a reference document, but not the link itself, where the link may be a URL for the referenced document embedded in the referring document.

In the last full paragraph on page 3 of the Office Action, the Examiner rejected claim 1 due to the use of ordinal words (first, second and third), due to the lack of these words in the

specification. It is submitted that there is no basis in the law or regulations for requiring the use of ordinal words in the specification to use such words in claims. However, to aid the Examiner in understanding the claimed invention, these words have been replaced with other adjectives which do appear in the specification, although the resulting language uses more words possibly will make it more difficult for one of ordinary skill in the art to understand the scope of the invention. The revised claim language uses the term "collected document group" which occurs over 50 times in the specification, "referenced documents" which occurs at least twenty times in the specification and "referring documents" which occurs at least twice as a plural and at least ten more times in the singular form. Even the term "newly collected document group" occurs twice in the specification. For the above reasons, withdrawal of the rejection under the first paragraph of 35 USC § 112 of claim 1 and claims 2-5 which depend therefrom is respectfully requested.

In the first paragraph on page 3 of the Office Action, the Examiner rejected claim 16 under the first paragraph of 35 USC § 112 for failure to find "a concise description of above original documents and other documents" in the specification. Therefore, the recitation of what the significance level indicates has been changed to "an importance of a document based on information about references in a collected document group, and information indicating a position of the document" (claim 16, last two lines). This corresponds to the description at page 9, line 18 to page 10, line 3. Withdrawal of the rejection of claim 16 under the first paragraph of 35 USC § 112 is respectfully requested.

As indicated in the title and at the end of this document, the Examiner is respectfully requested to contact the undersigned by telephone to arrange an Examiner Interview if the changes that have been made do not result in withdrawal of the rejections under the first and second paragraphs of 35 USC § 112.

Rejections under 35 USC § 112, Second Paragraph

On pages 3 and 4 of the Office Action, the Examiner rejected claims 1-5 and 16 under the second paragraph 35 USC § 112 due to the same language for which the Examiner found insufficient support in the specification. Since the language has been amended, withdrawal of the rejection or a telephone call to the undersigned prior to issuing another Office Action to discuss what further changes are necessary, is respectfully requested.

Rejection under 35 USC § 102(e)

On pages 4 and 5 of the Office Action, claim 16 was rejected under 35 USC § 102(e) as anticipated by Chidlovskii et al. The first four lines of the rejection were identical to the rejection of claim 16 under 35 USC § 102(e) in the December 20, 2004 Office Action and the last four lines added a description of where a teaching of the significance level could allegedly be found in Chidlovskii et al.

In the second paragraph on page 13 of the Office Action in the Response to Arguments, the Examiner apparently indicated that claim 16 was being rejected because the limitations therein were not understood. Hopefully the amendments made to claim 16 will enable the Examiner to understand what is being recited therein and the rejection under 35 USC § 102(e) will be withdrawn. If not, the Examiner is respectfully requested to contact the undersigned prior to issuing another Office Action, so that the Examiner's understanding of claim 16 or lack thereof can be conveyed to the undersigned so that appropriate amendments can be made to claim 16 to clarify the invention as recited therein, thereby expediting proper examination of the claims.

Rejection under 35 USC § 103(a)

On pages 5-8 of the Office Action, claim 1, 10, 11, 14, 15, 18, 19, and 21 were rejected under 35 USC § 103(a) as unpatentable over Flake. The wording of this rejection was unchanged from the December 20, 2004 Office Action. On pages 14 and 15 of the Office Action in the Response to Arguments, the Examiner asserted that "collecting documents that have already been grouped into documents in a community and documents outside the community and furthermore collecting documents after creation of a community or subset ... are not recited in the rejected claim(s)" (Office Action, page 14, lines 3-5) and then in the paragraph spanning pages 14 and 15 it was acknowledged that the claims were not being read as consistent with the specification and due to the rejection under second paragraph of 35 USC § 112, were not being given the meaning intended by the applicant.

As noted above, claim 1 has been extensively amended in an effort to use language which the Examiner will be able to understand. As discussed in the Amendment filed April 19, 2005, contrary to the assertion that the "collection of seed document which is referred to as a source document reads on the claimed first documents" (Office Action, lines 9-10), all of the "seed documents" in Flake are used in collecting additional documents. This is not how documents are collected according to the present invention. Nothing has been cited or found in Flake suggesting that the seed documents are "collected from inside a community ... based on a reference of each document in the collected document group" (claim 1, lines 5-6) and then

"collecting a newly collected document group from inside and outside the community based on the reference of the collected document group from inside the community" (claim 1, last three lines).

If the Examiner fails to see the distinction between Flake and the present invention as recited in claim 1, the Examiner is respectfully requested to contact the undersigned by telephone prior to issuing another Office Action, so that the differences between the invention and Flake can be discussed and further amendments made to claim 1, if necessary prior to further examination.

Claims 10, 11, 14, and 15 depend from claim 1 and therefore patentably distinguish over Flake for at least the reasons discussed above and in the April 19, 2005 Amendment.

In rejecting claim 18, the Examiner cited column 4, lines 23-32 of Flake describing separation of a database "into two subsets such that one subset 102 contains all documents that are 'similar' to the prototypes 100, and the other subset contains all documents that are 'dissimilar'" (column 4, lines 25-28). This is the end result of the selection of documents in the system by Flake. On the other hand, claim 18 recites use of such groups as the starting point, i.e., "determining a prospect to be collected next based on a reference relation between a positive sample document group which is a document group related to a field and a negative sample document group which is a document group less related to the field" (claim 18, lines 3-6). Nothing has been cited or found in Flake suggesting the use of a "negative sample document group" for the purpose of finding additional documents. Therefore, it is submitted that claim 18 patentably distinguishes over Flake.

Claims 19 and 21 have been amended so that they can continue differ from claim 1 primarily in the preamble. The limitations recited in the body of claims 19 and 21 are sufficiently similar to claim 1 that the same arguments apply. Therefore, it is submitted that claims 19 and 21 patentably distinguish over Flake for the reasons discussed above with respect to claim 1.

On page 8-12 of the Office Action, claims 2-5, 7, 12, 13, 17 and 20 were rejected under 35 USC § 103(a) as unpatentable over Flake in view of Diamond, Goerz, Jr. et al., or Aoki et al. using the same language as in the December 20, 2004 Office Action except for the paragraph on page 10 which previously referred to "Sundaresan". It is submitted that the changes to this paragraph do not affect the arguments set forth in the April 19, 2005 Amendment. Therefore, it is submitted that claims 2-5, 12 and 13 which depend from claim 1 patentably distinguish over any combination of Flake, Diamond, Goerz, Jr. et al. and Aoki et al. for the reasons discussed above with respect to claim 1 and in the April 19, 2005 Office Action.

In the final paragraph on page 15 of the Office Action, the Examiner noted that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." Applicant totally agrees with this statement. However, the fact that the Examiner made this statement suggests that the Examiner did not understand what was said in the April 19, 2005 Amendment and substantially repeated in the preceding paragraph. As stated therein, it is **combinations** of these references which fails to teach the claimed invention because the addition of the secondary references does not overcome the deficiencies of Flake discussed above with respect to claim 1. The June 14, 2005 Office Action failed to rebut this argument and therefore, it is submitted that claims 2-5, 12 and 13 should be allowed if claim 1 does not continue to be rejected as unpatentable over Flake.

As noted above, the rejection of claims 7, 8, 12, and 20 as unpatentable over Flake in view of Diamond has changed by citing teachings of Diamond, instead of "Sundaresan" in the first full paragraph on page 10 of the Office Action. The newly cited portions of Diamond only relate to an alleged teaching of "collecting a document having a high reference score as the document to be collected" (Office Action, page 10, line 5) and "tailoring additional queries" (Office Action, page 10, line 9). Nothing was cited in Diamond suggesting use of "a negative sample document group" (e.g., claim 7, lines 3-4) to determine "a prospective document for collection that is related to the field based on a reference relation to the positive sample document group **and** the negative sample group" (claim 7, line 5-7, emphasis added). Since similar limitations are recited in claims 8 and 20, it is submitted that claims 7, 8 and 20 patentably distinguish over the combination of Flake in view of Diamond.

Request for Examiner Interview

If the Examiner continues to believe that any of the claims do not meet the requirements of both the first and second paragraphs of 35 U.S.C. § 112, the Examiner is respectfully requested to contact the undersigned by telephone to arrange and Examiner Interview prior to issuing the next Office Action, to enable the undersigned to learn what language the Examiner will find satisfactory.

Summary

It is submitted that the references cited by the Examiner, taken individually or in combination, do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-5, 7, 8 and 10-22 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

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If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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